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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 10/643,655 | 08/19/2003 | Jim Irving Jones | D/A2482 | 5258 |
| 25453 7590 07/21/2008 PATENT DOCUMENTATION CENTER XEROX CORPORATION 100 CLINTON AVE., SOUTH, XEROX SQUARE, 20TH FLOOR ROCHESTER, NY 14644 | | | | |
| EXAMINER PARKER, BRANDI P | | | | |
| ART UNIT 3623 | | PAPER NUMBER | | |
| MAIL DATE 07/21/2008 | | DELIVERY MODE PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/643,655

Applicant(s)

JONES, JIM IRVING

Examiner

BRANDI P. PARKER

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 8/19/2003
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Claims 1-7 are pending in this Office Action.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Claim 1 merely is directed to managing knowledge within an enterprise with the end result of classifying the knowledge according to the knowledge taxonomy. Therefore, as the claims are not sufficiently tied to an apparatus, such as a computer, and/or do not transform the underlying subject matter (from your claim) to a different state the claimed method is non-statutory and therefore rejected under 35 U.S.C. 101. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972).

5. Claims 2-7 are also rejected for failing to be sufficiently tied to an apparatus or a particular technology and for being dependent upon rejected claim 1.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3-4 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldthorpe (US 2004/0249832).
8. With respect to claims 1, 4 and 6, Goldthorpe teaches a method for managing knowledge within an enterprise, comprising:
- a. defining a body of knowledge for the enterprise comprising skills, theories, rules, processes, techniques, instructions for action used by the enterprise to solve problems and to produce output, some of which has been recorded in documents and some of which is unrecorded form (paragraph 0036);

- b. analyzing the body of knowledge to identify a plurality of knowledge objects, wherein a knowledge object comprises specific knowledge contained within the body of knowledge which is used by an enterprise process to produce an output having value to the enterprise (paragraph 0007, 0008);
- c. defining a measurable business environment comprising a plurality of measurable enterprise processes, wherein the plurality of enterprise processes use the plurality of knowledge objects to produce the outputs having value to the enterprise and measuring the flow of each knowledge object through its associated measurable enterprise process to produce the associated output to determine a baseline flow for the knowledge object (paragraph 0063);
- d. modifying the enterprise process and measuring the flow of the knowledge object through the modified enterprise process until an optimized flow for the knowledge object has been achieved (paragraph 0072, 0081 – best practices and benchmarks create optimized flow);
- e. capturing any unrecorded knowledge objects and recording them in documents (paragraph 0071, regarding tacit knowledge);

- f. defining a knowledge taxonomy for the enterprise comprising a classification system for classifying the plurality of knowledge objects for the enterprise (paragraph 0051); and
 - g. classifying the body of recorded knowledge objects according to the knowledge taxonomy for the enterprise (paragraph 0051-0059, 0064).
- 9. Regarding claim 3, Goldthorpe teaches the method of claim 1, wherein defining a body of knowledge comprises:
 - h. collecting data pertaining to skills, theories, rules, processes, techniques, instructions for action used by the enterprise to solve problems and to produce output (paragraph 0036);;
 - i. transforming the collected data into information comprising summaries and correlations of data (paragraph 0046); and
 - j. validating the information using analytical, statistical and logical methods or by peer group review to produce knowledge (paragraph 0063, regarding the review stage of the knowledge content process cycle).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 2, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldthorpe (US 2004/0249832).

12. As to claim 2, Goldthorpe teaches the method of claim 1, further comprising:

k. periodically re-defining the body of knowledge for the enterprise to include new skills, theories, rules, processes, techniques, instructions for action used by the enterprise to solve problems and to produce output, some of which has been recorded in documents and some of which is unrecorded form and to remove those skills, theories, rules, processes, techniques, instructions for action which are no longer used by the enterprise to solve problems and to produce output and periodically re-analyzing the body of knowledge to identify additional knowledge objects contained within the body of knowledge to be included in the plurality of knowledge objects (paragraph 0075; regarding learning cycle of the knowledge manager where new data is created, captured or stored).

Goldthorpe does not explicitly teach removing no longer needed knowledge objects from the plurality of knowledge objects. However, claim 2 would be a predictable result of the method and system disclosed in Goldthorpe because removing outdated or unnecessary data objects during the evolution of a business consist of a known method in industry to maintain efficiency in business analysis. *KSR v. Teleflex*, 82 USPQ2d, 1385 (2007). Therefore, it would have been obvious to one with ordinary skill in the art to remove unwanted knowledge objects from the plurality of knowledge objects.

As to claim 5, Goldthorpe teaches a creating a knowledge taxonomy for a business enterprise relating to various aspects of management (paragraph 0051-0059, 0064). Goldthorpe does not explicitly teach wherein the knowledge taxonomy initially classifies documents according to competitive documents, transactional documents, capability documents and external documents. However, a predictable result of the method and system in Goldthorpe would be the implementation of the specific classification according to the needs of the organization. *KSR v. Teleflex*, 82 USPQ2d, 1385 (2007). Therefore, it would have been obvious to one with ordinary skill in the art to use the system in Goldthorpe to classify documents into the specific categories of competitive, transactional, capability and external documents.

13. With respect to claim 7, Goldthorpe teaches using business management strategies common management tools and techniques to determine best practices and

benchmarks for the business enterprise paragraph 0081-0088). Goldthorpe does not explicitly teach the usage of a Six Sigma framework. It has been held that express suggestion to substitute one equivalent technique for another need not be present to render applications are obvious in view of the prior art if what is claimed is no more than simple substitution of one known element for another, or mere application of a known technique a piece of prior art. *Ex Parte Smith*, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007) Therefore, it would have been obvious to one with ordinary skill in the art to substitute one known business management strategy for another by substituting the Six Sigma framework for the business management strategies provided in Goldthorpe to reject claim 7.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Harhen (US 5406477, apparatus for enterprise management), Havens (US 5924072, removing unwanted knowledge objects), Copperman et al (US 6711585, knowledge management system), Hill (US 5745893, system for arrangement of documents), Crabtree (US 5937084, knowledge based document analysis system), and Presnell (US 6182067, system for knowledge management).

Art Unit: 3623

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDI P. PARKER whose telephone number is (571) 272-9796. The examiner can normally be reached on Mon-Thurs. 8-5pm.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRANDI P PARKER/
Examiner, Art Unit 3623

/Andre Boyce/
Primary Examiner, Art Unit 3623